

REMARKS

Summary of the Office Action

Claims 1-3 are pending in the application.

Claims 1-3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art (Fig. 1) in view of Hiroshi (JP-624754). Applicant respectfully traverses these rejections.

Analysis of the Rejection of Claims 1-3

The rejection of claims 1-3 is based on the same reasoning as the rejection of these claims in the previous Office Action dated June 21, 2005. In response to that Office Action, it was argued that claims 1-3 are not rendered obvious by the combination proposed by the Examiner at least because the combination of references fail to teach or suggest the claimed detector in combination with the claimed AGC.

In particular, it was argued that claim 1 recites "a detector for detecting a gain control level corresponding to the difference obtained by comparing the levels of the baseband signals of the two channels output by the filter with a predetermined level", but Fig. 27(b) of Hiroshi shows a gain control circuit 4202 that outputs a signal based upon an integrated value of a difference between a reference signal and the sum of two other signals. This integrated value is applied to the amplifiers and is not analogous to the claimed "gain control level corresponding to the difference obtained by comparing the levels of the baseband signals of the two channels output by the filter with a predetermined level" and the AGC controlling gains according to the gain

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APP. NO. 09/738,900

control level detected by the detector. That is, because the output of element 4202 is an integrated value it does not correspond to the output of the subtractor shown in Fig. 27(b). At least for this reason, Hiroshi does not teach or suggest the claimed detector or the claimed AGC for controlling gains according to the gain control level detected by the detector.

In the present Office Action, the Examiner responds to that argument by stating that:

Hiroshi discloses a detector (4202(a) and 4202(b)) for detecting a gain control level corresponding to the difference obtained by comparing the level of the baseband signals of the two channel (4203) by filter with a predetermined level. (See fig. 27 (a) and (b)) and Fig. 4 (elements 115, 116). Hiroshi further shows that the output from the subtractor being integrated. It is well settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (In re Nelson, 40 CCPA 708).

Omission of an Element and its function is obvious if the function of the element is not desired (Ex parte WU, 10 USPQ 2031).

First, Applicant respectfully disagrees with the Examiner's conclusion that the claimed invention differs from the combination of references in that the invention omits an element of the references. Rather, the applied references do not teach all the elements of the claim. That is, the applied references fail to teach or suggest "a detector for detecting a gain control level corresponding to the difference obtained by comparing the levels of the baseband signals of the two channels output by the filter with a predetermined level" and "an AGC for controlling gains of the baseband signal for each of the two channels output from the down mixer according to the

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APP. NO. 09/738,900

gain control level detected by the detector.” In more detail, the claim requires that the AGC control gains according to the gain control level of the detector, and this level corresponds to the difference obtained by comparing the levels of the baseband signals of the two channels output by the filter with a predetermined level. There is no element in the references that performs the function of the claimed AGC.

In *In re Nelson*, cited by the Examiner, the decision was based on the belief “that the omission of the two outer paper strips of the Bulis structure would [not] cause the other elements of the device to function differently from those which they normally would perform if the strips were present in that container.” This is different from the present case, however, in that omitting Hiroshi’s integrator would cause other elements of Hiroshi to perform differently. That is, if the integrator were to be removed from the circuit of Hiroshi, so that the output of the subtractor, rather than the output of the integrator, is directly applied to the downstream circuitry, then the functions of the downstream circuitry would have to be modified to accommodate this change. This is in sharp contrast to *In re Nelson*, where the strips could simply be removed without affecting the other elements of the structure.

The present case is also very different from *Ex parte Wu*. In that case, a claimed corrosion inhibitor was different from a corrosion inhibitor of a reference in that the corrosion inhibitor of the reference contained polybasic salts, whereas the claims in dispute did not. The Board found that it would have been obvious to omit the polybasic salts of the reference where the function attributed to such salt is not desired, such as in compositions for preventing corrosion in environments that do not encounter fresh water. So, *Ex parte Wu* also involved a

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APP. NO. 09/738,900

case where an element was simply omitted. This is very different from the present case, which does not simply involve omitting an element of the reference, but, in the Examiner's proposed combination, would require that the functions of other elements of the references be changed to accommodate the elimination of the integrator. There is no teaching or suggestion in the references for such a modification.

Second, Applicant respectfully submits that procedural processes which allow portions of the claims to be ignored are, at best suspect and, at worst, contrary to law. The case of In re Ochiai et al., 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), is illustrative. In Ochiai the CAFC soundly rejected *per se* rules of patentability. Thus, whether or not a claim recites patentable subject matter can only be determined on a case by case determination after considering each and every limitation recited in the claim. Since the CAFC has made it clear time and time again that it is **the claim as a whole which must be considered during examination**, statements regarding parts of the claim which are or are not given "patentable weight" are not well taken.

In the present case, the Examiner is relying on a principle that omission of an element is obvious if the remaining elements perform the same functions as before or if the function of the element is not desired. Applicant respectfully submits this is not enough to support a claim rejection. Rather, there must be some teaching or suggestion in the art for omitting an element, and for modifying the remaining structure to accommodate the fact that the element has been omitted.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APP. NO. 09/738,900

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

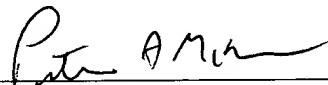
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER



Peter A. McKenna
Registration No. 38,551

Date: March 13, 2006